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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Jafar Nabkel, *et al.*

Application No.: 09/785,863

Filed: February 16, 2001

For: METHOD AND SYSTEM FOR
PROVIDING PRESELECTED
INFORMATION SERVICES UPON
DETECTION OF AN OFF-HOOK
CONDITION

Examiner: Rasha S. Al Aubaodi

Art Unit: 2642

APPELLANT BRIEF UNDER 37 CFR
§1.192

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

Appellants offer this Brief further to the Notice of Appeal mailed on April 15, 2003. This Brief is submitted in triplicate as required by 37 CFR §1.192(a).

1. Real Parties in Interest

The real party in interest is Qwest Communications International Inc..

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2. Related Appeals and Interferences

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

3. Status of Claims

Claims 1-5, 8-16, 19-27, and 30-38 are currently pending in the application. All pending claims stand rejected by the Examiner. Claims 2-5, 9-15, 20-26, and 31-37 are as originally filed on February 16, 2001. Claim 38 appears as originally presented by amendment on January 15, 2003. Claims 1, 16, and 27 were amended in response to the first Office Action that was mailed on April 9, 2002. These claims were amended a second time in response to the Office Action mailed on December 18, 2002. Claims 8, 19, and 30 were amended for the first and only time, also in response to the Office Action mailed on December 18, 2002. Also in response to that Office Action, claims 6, 7, 17, 18, 28, and 29 were cancelled and claim 38 was added.

The rejections of Claims 1-5, 8-16, 19-27, and 30-38 are believed to be improper and are the subject of this appeal. Each of these claims has been rejected at least twice. A copy of claims 1-5, 8-16, 19-27, and 30-38 as rejected is attached as an Appendix.

4. Status of Amendments

No amendments have been filed subsequent to the most recent rejection, mailed March 20, 2003.

5. Summary of the Invention

In one embodiment, the claimed invention relates to methods and systems for providing information services to a subscriber. In doing so, the invention replaces the well-known “dial tone” that a telephone subscriber would otherwise hear with useful information of the subscriber’s choosing (Application, p. 6, ll. 1-3). Thus, when the subscriber goes off-hook, instead of hearing the dial tone, which informs the subscriber that his telephone is in working order and available to make place a call, the subscriber hears information such as news, weather, sports, stock market reports, and the like that the subscriber has pre-selected (*id.*, p. 7, ll. 15-25). Further, the information is presented in accordance with a schedule and/or frequency that the subscriber has pre-selected. Thus, if the subscriber goes “off hook” multiple times within a brief period of time, the subscriber is not necessarily presented with the same information multiple times (*id.*, p.6, ll. 18-28).

The variety of information and schedule for presenting it are stored in a subscriber profile. The subscriber may alter the profile as the subscriber chooses (*id.*). When the telephone system determines that the subscriber has gone “off hook,” the subscriber’s profile is consulted to determine what information should be presented to the subscriber (*id.*, p. 6, l. 29 – p. 7, l. 14). The telephone system may comprise networks such as an advanced intelligent network and/or the public switched telephone network (*id.*, p.5, ll. 1-8).

The information presented to the subscriber may include audio, video, text, and/or graphics (*id.*, p. 9, ll. 22-25). Further, the subscriber may interactively control the content of the information by entering codes, such as numeric digits on a telephone keypad (*id.*, p. 8, ll. 3-8)

The subscriber may terminate the delivery of information by going “on hook” or initiating a call by, for example, dialing a telephone number using a telephone keypad which generates DTMF (dual tone multi-frequency) tones (*id.*, p. 10, ll. 3-6).

6. Issue

Whether under 35 U.S.C. § 103(a) Claims 1-5, 8-16, 19-27, and 30-38 are unpatentable over U.S. Patent No. 5,222,120 to McLeod, *et al.* (hereinafter “McLeod”) in view of U.S. Patent No. 6,373,817 to Kung *et al.*, (hereinafter “Kung”). Section 1 beginning on page 2 of the Office Action mailed on February 11, 2003 (paper no. 18, hereinafter “the Office Action”) describes the Examiner’s position on this issue, supplemented by remarks accompanying the Advisory Action mailed on March 20, 2003 (paper no. 20, hereinafter “the Advisory Action”).

7. Grouping of the Claims

For purposes of this appeal, all pending claims (1-5, 8-16, 19-27, and 30-38) are grouped together, and all pertain to the issue presented above.

Although the claims are grouped together, Appellants reserve the right outside the context of this appeal to argue independent patentability of any grouped claims.

8. Argument

Each of claims 1-5, 8-16, 19-27, and 30-38 stands rejected under 35 U.S.C. §103(a) as unpatentable over McLeod in view of Kung. In addressing the rejections of these claims below, it is useful as an initial matter to discuss the disclosures of McLeod and Kung.

McLeod discloses a long distance switching system that is adapted to provide enhanced subscriber services, including audio news and information service. (McLeod, Abstract) To access these services, a subscriber initiates a long distance telephone call (*id.*, col. 4, ll. 25-29). To the extent McLeod discloses the delivery of information services, it does so only upon the entry of a command by the subscriber and

then only in the form of an audible menu from which the subscriber chooses the information to receive (*id.*, col. 24, ll. 29-57). Nothing in McLeod suggests providing information services upon detection of an “off hook” condition of the subscriber’s phone nor the delivery of information except by means of the audible menu.

Kung discloses a “chase me” system for routing messages to subscribers (Kung, Abstract). In one aspect, Kung discloses that an announcement server may detect when a device has been taken off-hook and play random advertisements or other announcements to the user (*id.*, col. 10, ll. 13-15). Nothing in Kung suggests the delivery of information services according to a schedule and frequency pre-established by a subscriber.

To support a rejection under 35 U.S.C. §103, the Examiner is charged with factually supporting a *prima facie* case of obviousness. Manual of Patent Examining Procedure, Eighth Edition, First Revision, February, 2003 (hereinafter “MPEP”) 2142. Such a *prima facie* case requires, *inter alia*, that all limitations of the claims be taught or suggested by the cited reference(s) and that there be some suggestion or motivation to combine or modify the reference teachings as the Examiner proposes. MPEP 2143. The rejections of all claims are deficient in at least both these respects.

1. Missing Limitations

The claims include four pending independent claims, Claims 1, 16, 27, and 38, which respectively recite a system and methods for providing information services to a subscriber. The limitations of these claims require, *inter alia*, “in response to [an] off-hook condition, generating a message corresponding to ... selected information services for receipt by [a] subscriber.” The information services are provided according to criteria established by the subscriber, which includes the “frequency” for delivering the services (claim 38) or the “time, date, or day of the week” for delivering the services (claims 1, 16, and 27). These limitations are simply not taught by either McLeod or Kung.

With respect to certain of these limitations, the Examiner states that “ ‘The predetermined criteria includes the time, date or day of the week’ in the subscriber’s profile would obviously reflect how often a service such as the news or the weather would be provided. The subscriber would obviously not want to listen to the weather report every 5 minutes.” (Office Action). The Appellants disagree with this assertion. More importantly, however, the Examiner does not cite a reference that teaches or suggests this limitation, despite repeated requests by the Appellants for the Examiner to do so. (The Examiner does not even address the limitation of claim 38 that the subscriber selects a frequency for receiving information services). In fact, in response to the Appellant’s requests that the Examiner cite references for all claim limitations, the Examiner has stated, “Applicant’s request that the examiner provide a reference for every single limitation is unreasonable.” (Advisory Action) Appellants are at a loss to conceive how the Examiner can simply dismiss advantageous limitations as “obvious” without citing a reference.

The Appellants have assumed the Examiner to be relying on official notice to supply the missing limitations, in which case the Appellants have traversed the rejection and requested either an express showing of documentary proof or an affidavit specifically stating facts within the personal knowledge of the Examiner, as required by 37 CFR § 1.104(d)(2). Neither, however, have been forthcoming.

The Appellants, therefore, believe claims 1, 16, 27, and 38 are in condition for allowance, at least for this reason, along with all the dependant claims which all depend from one of these independent claims.

2. Lack of Motivation to Combine References

Furthermore, the Appellants note that there is no basis, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine McLeod and Kung in the manner suggested by the Examiner. *See* MPEP 2143. Additionally, despite repeated requests by the Appellants to do so, the

Examiner has not cited a reference that provides the necessary suggestion or motivation to combine the references as suggested by the Examiner. Instead, the Examiner has responded by reciting case law. To wit,

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. (Advisory Action, citations omitted, emphasis in original)

Applicants assume that by emphasizing this portion of the remarks, the Examiner is implying that the Examiner may simply claim something is within the "knowledge generally available to one of ordinary skill in the art" without more. It is this assertion that the Appellants have repeatedly traversed.

Once again, the Appellants have assumed the Examiner to be relying on official notice, in this case to supply the teaching, suggestion or motivation to combine the references. The Appellants have traversed the rejections and requested either an express showing of documentary proof or an affidavit specifically stating facts within the personal knowledge of the Examiner to support the apparent official notice, as required by 37 CFR § 1.104(d)(2). Neither, however, have been forthcoming.

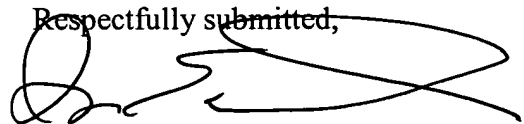
Further, Applicants contend that modifying McLeod in light of Kung would render McLeod's invention unsatisfactory for its intended purpose. Applicants note that "[i]f proposed modifications would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modifications." (MPEP 2143.01) McLeod teaches a system whereby a user may select specific information services from an audible menu. Kung teaches delivering random information in response to an off-hook condition. Thus, modifying McLeod with the teachings of Kung would produce a system that frustrates a user who is attempting to access specific information by forcing the user to hear random information.

Thus, the Appellants believe all pending claims are in condition for allowance for this additional reason.

9. Conclusion

Appellant believes that the above discussion is fully responsive to all grounds of rejection set forth in the application. Please deduct the requisite fee of \$320.00 pursuant to 37 C.F.R. §1.17(c) from Deposit Account 20-1430 and any additional fees that may be due in association with the filing of this Brief.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Irvin E. Branch', written over the text 'Respectfully submitted,'.

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APPENDIX

The claims pending in the application are as follows:

1. (Previously Twice Amended) In a communication network comprising a plurality of subscriber telephone lines, each coupled to an associated telephoning switching facility, each subscriber telephone line having at least one directory number and an associated subscriber profile including selected information services, a method for providing information services to a subscriber, comprising:

detecting an off-hook condition at a subscriber telephone line;

determining the information services selected by the subscriber by correlating the subscriber directory number with the selected information services in the subscriber's profile in accordance with predetermined criteria, wherein the predetermined criteria includes the time, date, or day of week; and,

in response to the off-hook condition, generating a message corresponding to the selected information services for receipt by the subscriber.

2. (As Filed) A method as in claim 1, wherein the message is an audio message.

3. (As Filed) A method as in claim 1, wherein the message is a text message.

4. (As Filed) A method as in claim 1, wherein the message is a video message.

5. (As Filed) A method as in claim 1, wherein the message is a graphic message.

6. (CANCELLED)

7. (CANCELLED)

8. (Previously Once Amended) A method as in claim 1, wherein the predetermined criteria includes the time since the last detected "off-hook" condition.

9. (As Filed) A method as in claim 1, wherein while receiving the message, or after the message completes, entering one of a plurality of codes by the subscriber accesses additional information.

10. (As Filed) A method as in claim 9, wherein entering a code by the subscriber accesses the subscriber's correspondence messaging service.

11. (As Filed) A method as in claim 1, wherein the communication network is an advanced intelligent network (AIN).

12. (As Filed) A method as in claim 1, wherein the communication network is a public switched telephone network.

13. (As Filed) A method as in claim 1, wherein selecting an appropriate calling number by the subscriber terminates the message.

14. (As Filed) A method as in claim 13, wherein the subscriber selects an appropriate calling number by generating DTMF (dual tone multi-frequency) tones.

15. (As Filed) A method as in claim 1, wherein the message is terminated when the subscriber goes "on hook" by hanging up the line.

16. (Previously Twice Amended) In a wireless communication network comprising a plurality of subscriber telephone lines, each coupled to an associated telephone switching facility, each subscriber telephone line having at least one directory number and an associated subscriber profile including selected information services, a method for providing information services to a subscriber, comprising:

detecting at a switching facility an off-hook condition at a subscriber telephone line;

determining the information services assigned to a subscriber by correlating the subscriber directory number with the selected information services in the subscriber's profile in accordance with predetermined criteria, wherein the predetermined criteria includes the time, date, or day of week; and,

in response to the off-hook condition, generating an audio message corresponding to the assigned information services for receipt by the subscriber in place of dial tone.

17. (CANCELLED)

18. (CANCELLED)

19. (Previously Once Amended) A method as in claim 16, wherein the predetermined criteria includes the time since the last detected "off-hook" condition.

20. (As Filed) A method as in claim 16, wherein while receiving the message, or after the message completes, entering one of a plurality of codes by the subscriber accesses additional information.

21. (As Filed) A method as in claim 20, wherein entering a code by the subscriber accesses the subscriber's correspondence messaging service.

22. (As Filed) A method as in claim 16, wherein the communication network is an advanced intelligent network (AIN).

23. (As Filed) A method as in claim 16, wherein the communication network is a public switched telephone network.

24. (As Filed) A method as in claim 16, wherein selecting an appropriate calling number by the subscriber terminates the message.

25. (As Filed) A method as in claim 24, wherein subscriber selects an appropriate calling number by generating DTMF (dual tone multi-frequency) tones.

26. (As Filed) A method as in claim 16, wherein the message is terminated when the subscriber goes "on hook" by hanging up the line.

27. (Previously Once Amended) In a communication network comprising a plurality of subscriber telephone lines, each coupled to an associated telephoning switching facility, each subscriber telephone line having at least one directory number and an associated subscriber profile including selected information services, a system for providing information services to a subscriber, comprising:

means for detecting an off-hook condition at a subscriber telephone line;

means for determining the information services selected by the subscriber by correlating the subscriber directory number with the selected information services in the subscriber's profile in accordance with predetermined criteria, wherein the predetermined criteria includes the time, date, or day of week; and,

means for generating an audio message, in response to the off-hook condition, corresponding to the selected information services for receipt by the subscriber.

28. (CANCELLED)

29. (CANCELLED)

30. (Previously Once Amended) A method as in claim 27, wherein the predetermined criteria includes the time since the last detected "off-hook" condition.

31. (As Filed) A method as in claim 27, wherein while receiving the message, or after the message completes, entering one of a plurality of codes by the subscriber accesses additional information.

32. (As Filed) A method as in claim 31, wherein entering a code by the subscriber accesses the subscriber's correspondence messaging service.

33. (As Filed) A method as in claim 27, wherein the communication network is an advanced intelligent network (AIN).

34. (As Filed) A method as in claim 27, wherein the communication network is a public switched telephone network.

35. (As Filed) A method as in claim 27, wherein selecting an appropriate calling number by the subscriber terminates the message.

36. (As Filed) A method as in claim 35, wherein the subscriber selects an appropriate calling number by generating DTMF (dual tone multi-frequency) tones.

37. (As Filed) A method as in claim 27, wherein the message is terminated when the subscriber goes "on hook" by hanging up the line.

38. (As Filed) A method of providing information services to a subscriber, comprising:

receiving a selection of information services from a subscriber, including a frequency with which the subscriber selects to receive the information services;

storing the selection of information services and the frequency as a subscriber profile relating to the subscriber;

detecting, via a communications network, an off-hook condition at a subscriber line relating to the subscriber;

consulting the subscriber profile relating to the subscriber to determine the information services selected by the subscriber; and

in response to the off-hook condition, providing the information services to the subscriber via the communications network.